

REMARKS

Claims 1-37 are currently pending in the subject Application.

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. ("*Cupps*") in view of U.S. Patent No. 4,971,406 to Hanson ("*Hanson*") and U.S. Patent No. 5,895,454 to Harrington ("*Harrington*").

Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of U.S. Patent No. 4,797,818 to Cotter ("*Cotter*").

Applicant respectfully submits that all of Applicant's arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner's rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*. Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of *Cotter*.

Applicant respectfully submits that the ***amendments to independent Claims 1, 13, 23, and 24 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** Applicant further respectfully submits that amended independent Claims 1, 13, 23, and 24 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Cupps*, *Hanson* and *Harrington*, either

individually or in combination. Thus, Applicants respectfully traverse the Examiner's obvious rejection of Claims 1-37 under 35 U.S.C. § 103(a) over the proposed combination of *Cupps*, *Hanson*, *Harrington*, and *Cotter*, either individually or in combination.

The Proposed *Cupps-Hanson-Harrington* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

Applicant respectfully submits that *Cupps*, *Hanson* and *Harrington*, either individually or in combination, fail to disclose, at least "preference information for at least one of the plurality of buyers, wherein the preference information comprises a maximum price preference, a minimum price preference, and a restaurant rating preference," as required in Claim 1, as amended. A plain reading of *Harrington* (alone and/or in combination with *Cupps* and/or *Hanson*) reveals that *Harrington* simply fails to disclose, teach, suggest, a "database" (or, "means for storing" in claim 23) having "*a maximum price preference, a minimum price preference, and a restaurant rating preference*" as claimed in Claims 1, as amended. The portions of *Harrington* relied upon by the Examiner (and *Harrington* in its entirety), clearly fails to disclose a database/means for storing having "*a maximum price preference, a minimum price preference, and a restaurant rating preference*."

The Examiner asserts that "Harrington discloses a system using the internet where in addition to other criteria *such as price* etc...the delivery time is included to the customer in a hierarchical scheme, in other words rank, *from a plurality of sellers for comparison...*" (22 December 2008 Office Action, page 3). (Emphasis added). Even accepting the construction of *Harrington* that the Examiner has set forth, with which Applicant does not admit, it is clear that *Harrington* (alone or in combination) fails to disclose a database having "*a maximum price preference, a minimum price preference, and a restaurant rating preference*." Significantly, the price consideration in *Harrington* merely relates, if at all, to providing a buyer with price information to be *considered* in a comparison by the buyer. Therefore, for at least the foregoing reasons, it is clear that *Harrington* in no way discloses "*a maximum price preference, a minimum price preference, and a restaurant rating preference*," as required by Claim 1, as amended.

Moreover, *Cupps*, *Hanson* and *Harrington* likewise each fail to disclose, teach or suggest a database ("means for storing" – claim 23) that includes "*a maximum price*

preference, a minimum price preference, and a restaurant rating preference” as required by Claim 1, as amended. While in *Harrington*, a user may be provided with certain information for comparison by the buyer, it is clear that a “*restaurant rating preference*” is absent both from any database in *Harrington*, as well as a factor in generating any list in *Harrington*. There is simply no question that the proposed *Cupps, Hanson* and *Harrington* combination utterly fails to disclose a “*restaurant rating preference*” of at least one of the plurality of buyers. Significantly, the cited portions of *Cupps, Hanson* and *Harrington* relied upon by the Examiner (and even those references in their entirety), clearly fail to disclose, among other things a “*restaurant rating preference*” of at least one of the plurality of buyers, as required by Claim 1, as amended.

The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Cupps, Hanson, Harrington*, or *Cotter*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As

stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Cupps, Hanson, Harrington*, and *Cotter*. The Office Action merely states that “it would have been obvious for the buyer to include preferences such as the price range” and “it would have been obvious for one of ordinary skill in the art to provide for the automatic selection of a seller in modified *Cupps* based on real time delivery time as disclosed in *Cotter*.” (22 December 2008 Office Action, pages 3-4). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the **factual findings necessary to establish obviousness** and is not a sufficient **explanation to support the obviousness rejection** based on the proposed combination of *Cupps, Hanson, Harrington*, and *Cotter*. **Applicant respectfully requests the Examiner to provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.** (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided *an indication of the level of ordinary skill. Applicant respectfully requests the Examiner to provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that *Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.* (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and *See* 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant’s invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to *explain why the difference(s) between the proposed combination of Cupps, Hanson, Harrington, Cotter, and Applicant’s claimed invention would have been obvious to one of ordinary skill in the art.* The Office Action merely states that “so that time is not wasted considering unwanted options” and “in order to save time to the customer.” (22 December 2008 Office Action, page 3). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement *explains why the difference(s) between the proposed combination of Cupps, Hanson, Harrington, Cotter, and Applicant’s claimed invention would have been obvious to one of ordinary skill in the*

art. Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant’s claimed invention would have been obvious.* For example, the *Examiner has not adequately supported the selection and combination of Cupps, Hanson, Harrington, and Cotter to render obvious Applicant’s claimed invention.* The Examiner’s unsupported conclusory statements that “it would have been obvious for the buyer to

include preferences such as the price range [...] it would have been obvious for one of ordinary skill in the art to provide for the automatic selection of a seller in modified Cupps based on real time delivery time as disclosed in Cotter [...] so that time is not wasted considering unwanted options [...] in order to save time to the customer,” ***does not adequately provide clear articulation of the reasons why Applicant’s claimed invention would have been obvious.*** (22 December 2008 Office Action, pages 3-4). In addition, the Examiner’s unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious Applicant’s claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Cupps, Hanson, Harrington, and Cotter*, ***Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.***

Applicant’s Claims are Patentable over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination

As mentioned above, Claims 1, 13, 23, and 24 are considered patentably distinguishable over *Cupps, Hanson, Harrington, and Cotter*.

With respect to dependent Claims 2-6, 8-12, 14-16, 18-22, 25-29, and 31-37: Claims 2-12 depend from Claim 1; Claims 14-22 depend from Claim 13; Claims 25-37 depend from Claim 24. As set forth above, each of Claims 1, 13, 23, and 24 are considered patentably distinguishable over the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. Thus, dependent Claims 2-6, 8-12, 14-16, 18-22, 25-29, and 31-37 are considered to be in condition for allowance for at least the reason of depending from an allowable independent claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 1-37 are not rendered obvious by the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. Applicant further respectfully submits that Claims 1-37 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 1-37 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-37 be allowed.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

21 March 2009
Date

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